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530 7590 04/01/2009 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER MIZRAHI, DIANE D	
			ART UNIT 2617	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/518,992

**Applicant(s)**

KATO, JUNJI

**Examiner**

DIANE MIZRAHI

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- \_\_\_\_\_ Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- \_\_\_\_\_ Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 13-15 are currently pending in the subject application and are presently under consideration. Claims 1-12 have been added and are new claims. This office action is in response to the newly submitted amendment filed December 22, 2008.

Based on Applicant's amendment and arguments, a new office action is issued below. Examiner has reconsidered the amendment and remarks set forth in this office action. The 35 USC 101 rejection for claims 13, 15 and 16-17 and 19 is formally withdrawn.

### ***Response to Arguments***

Applicant argued features in the claims that assign points to the favorite content list by dividing a predetermined value by contents listed in the content list, thereby generating a recommendation list to the users, reads on Grossman in view of Handman. Grossman is discussing favorite contents by dividing predetermined points, such as a score is assigned, by ranking the highest ranked search of web pages and scoring them by assigning properties a when the score exceeds a predetermined threshold for favorites and Web search results ("History") and favorites. This provides the user with a variety of forms that allow the user to customize the search application in accordance with the user's preferences (Examiner notes the user creates their own list.) Thus, Grossman shows the limitation of assign points to the favorite content list by dividing a

predetermined value by contents listed in the content list, thereby generating a recommendation list to the users. Also, Handman teaches recommending a list such as provides a list of songs that are similar to the repertoire of an artist or CD, thereby, it will allow us to generate recommendations for an end user, purely on taste, without the need for a starting song. Thus the limitation of assigning points to the content in the favorite list of each users by dividing a predetermined point value by the total number of contents listed in the favorite content list.

Grossman did not specifically show the favorite list; however, this element was shown to be obvious to one of ordinary skill in the art as shown by Handman. Therefore, the argued features are written broad or are written such that they read upon the cited references.

In response to the applicant's argument that the references are not combinable, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Examiner believes that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonable pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24

USPQ2d 1443 (Fed. Cir. 1992). In this case, all references are concerned with recommendations of favorite lists and scoring the favorites lists.

Therefore the argued features are written broad or are written such that they read upon the cited reference. Examiner believes Gross in combination with Handman teaches Applicant's claimed invention. The prior art made of record are from the same field and both are solving similar problems.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over William Gross et al. ( US Publication No. 20040133564 A1 and Gross hereinafter) and further in view of Etienne Handman (US Publication No. 20060212444 A1 and Handman hereinafter).

Regarding Claims 13 and 14, Gross teaches a data processing apparatus (i.e. terminal, Figure 1, item 104 and Figure 5, item 502) [0173][0174] content to a user (i.e. such as subject, author, etc) [0073][0074] ;

comprising: receiving storing means for receiving storing favorite content lists via a network (i.e. network) [0077] (i.e. favorites includes content field and URL) [0075] received from a plurality of user terminal devices including the user terminal device corresponding to the user (i.e. terminal, Figure 1, item 104 and Figure 5, item 502) [0173][0174];

specifying portion for extracting (i.e. incremental indexing can be performed for files, emails, email attachments, Internet (or other network) search results, favorites, specific databases, and/or the like. Incremental indexing can be performed in direct response to a user command, continuously, periodically, and upon the occurrence of one or more specified conditions, generates and/or updates a corresponding index) [0077] and generating a content list by (i.e. generates and updates) [0077] comparing content listed in the received favorite content lists network (i.e. favorites includes content field and URL) [0075] [0077];

an assigning means for assigning points (i.e. a score can be assigned by the search system based on such properties, and if the score exceeds a predetermined threshold, the search system will categorize the page as a commercial or business web page) [0128]-[0130] to the content in each favorite content list (i.e. favorites includes content field and URL) [0075] in to a number of contents listed in the corresponding favorite content list (i.e. the quality of the links can be scored based on a variety of

parameters, including the number of different domains the links link to, how many links are alive or broken (i.e. a broken link is a hyperlink that does not work), and other parameters. Thus, for example, the higher the number of different domains the links link to and the greater the number or percentage of alive links) (Examiner's note: based on the percentage of the alive links, content lists of the favorites can be accessed) [0127];

and for assigning points (i.e. a score can be assigned by the search system based on such properties, and if the score exceeds a predetermined threshold, the search system will categorize the page as a commercial or business web page) [0128]-[0130]

and ranking means for ranking content in the generated content list based on the points assigned to the content ) [0128]-[0130].

Gross teaches created by the respective users (i.e. queries from end users, including queries submitted via the search application 102) Paragraph [0065] including a first user (i.e. the user can cause the search application to add the address or URL to the user's favorites list by activating the plus (+) button 322D. ) Paragraph [0134] see also (i.e. allow a user to customize) Paragraph [0096] see also (i.e. user can enter a search string) Paragraph [0097].

Gross teaches each of the users other than the first user (i.e. end user ... significant customizing by users) Paragraph [0148]. (Examiner notes that the other than the first user is inherent and can be the other users which includes other users).

In regarding to the newly added limitation -- *dividing a predetermined point value by total* --

Gross does not teach dividing a predetermined point value by total.

Handman teaches dividing a predetermined point value by total (i.e. song vectors S.sub.1 to S.sub.n have been retrieved, an average of all values for each characteristic of every song vector S.sub.1 to S.sub.n is calculated and populated into a "center" or virtual song vector: Center vector  $C = (\mu_{sub.i}, \mu_{sub.2}, \dots \mu_{sub.n})$   
 $\mu_{sub.1} = (s_{sub.1,1} + s_{sub.2,1} + \dots s_{sub.n,1})/n$  ) [0114] – [0115].

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Gross with the teachings of Handman to include the claimed, dividing a predetermined point value by total with the motivation to compare attributes of items the consumer previously indicated he or she enjoys with attributes of other items to identify items that the consumer might enjoy. Thus, for example, if the consumer enjoys "Dubliners" by James Joyce, "Ulysses" by James Joyce might be identified as another item the consumer may enjoy because both



"Dubliners" and "Ulysses" have a common attribute (the author, James Joyce), (Handman, [0004]).

Gross does not teach recommending and generating a content list indicating common contents by comparing the content listed in the stored favorite content lists and a recommendation list generation portion recommending and inverse proportional.

Handman teaches recommending (i.e. provides a list of songs that are similar to the repertoire of an artist or CD; it will allow us to generate recommendations for an end user) [0094] a generating means for generating a content list indicating common contents by comparing the content listed in the stored favorite content lists (i.e. Favorites" display features date, album purchase icon and song purchase item. Date provides information as to when the song was selectively associated with the "Favorites" list. Album purchase enables the selective purchase of the album (or other content object) from which the song originates. One way to enable the selective purchase of the album is to hyperlink album purchase to a web site such as the web site of Amazon.com, which sells albums. Song purchase enables the selective purchase of the song (or other content object). One way to enable the selective purchase of the song is to hyperlink song purchase icon to a web site such as the "iTunes" web site from Apple Computer Corp. that offers songs for sale)[0071]; a recommendation list generation portion recommending (i.e. provides a list of songs that are similar to the repertoire of an artist or CD; it will allow us to generate recommendations for an end user) [0094] and inverse proportional (i.e. using the suitability quotient function above,

the "Q" value for the song "With or Without You" in the context of the "U2" Station is 0.045 (i.e., 1,500 minus 96, divided by 31,271). Therefore, a positive "Q" value for that song in that context ) Paragraph [0154] see also (i.e. the confidence factor is by multiplying the result of a comparison between the center vector and another song vector by the inverse of the standard deviation value.) Paragraph [0117] (Examiner notes that Applicant has inversely proportional in Applicant's specification, as dividing total number of contents as shown in Figure 10, item ST33) . Therefore Examiner has taken the broadest interpretation).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Gross with the teachings of Handman to include the claimed, recommending and generating a content list indicating common contents by comparing the content listed in the stored favorite content lists and a recommendation list generation portion recommending and inverse proportion with the motivation to compare attributes of items the consumer previously indicated he or she enjoys with attributes of other items to identify items that the consumer might enjoy. Thus, for example, if the consumer enjoys "Dubliners" by James Joyce, "Ulysses" by James Joyce might be identified as another item the consumer may enjoy because both "Dubliners" and "Ulysses" have a common attribute (the author, James Joyce), (Handman, [0004]).

Regarding Claims 15 and 16, Gross teaches user terminal device connected to a data processing system (i.e. terminals 104 and 502) [0173]-[0174] content to a user (i.e. such as subject, author, etc) [0073][0074]; comprising:

transmitting means for transmitting (Figure 1, item 113) a content list and a request for a content list [0075] to a data processing apparatus via a network (i.e. network) [0077];

Gross teaches created by the respective users (i.e. queries from end users, including queries submitted via the search application 102) Paragraph [0065] including a first user (i.e. the user can cause the search application to add the address or URL to the user's favorites list by activating the plus (+) button 322D. ) Paragraph [0134] see also (i.e. allow a user to customize) Paragraph [0096] see also (i.e. user can enter a search string) Paragraph [0097].

Gross teaches each of the users other than the first user (i.e. end user ... significant customizing by users) Paragraph [0148] (Examiner notes that the other than the first user is inherent and can be the other users which includes other users).

and receiving means for receiving the requested content list [0075]; wherein the content list is specific to the user and is generated by [0077] assigning points [0128]-[0130] to the content in each favorite content list [0075] in inverse proportion to a number of contents listed in the corresponding favorite content list [0127],

generating a content list indicating common contents by comparing the content listed in the favorite content lists [0075][0077], and ranking content in the generated content list [0077] based on the points assigned to the content [0128]-[0130].

Gross does not teach generating the recommendation and not including the content of the user's favorite content list.

Handman teaches generating the recommendation and not including the content of the user's favorite content list [0094].

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Gross with the teachings of Handman to include the claimed, generating the recommendation and not including the content of the user's favorite content list with the motivation to compare attributes of items the consumer previously indicated he or she enjoys with attributes of other items to identify items that the consumer might enjoy. Thus, for example, if the consumer enjoys "Dubliners" by James Joyce, "Ulysses" by James Joyce might be identified as another item the consumer may enjoy because both "Dubliners" and "Ulysses" have a common attribute (the author, James Joyce), (Handman, [0004]).

Regarding Claim 17, Gross teach transmitting means for transmitting the content list to the user terminal device (i.e. terminals 104 and 502) [0173]-[0174].

Gross does not expressly teach recommendation.

Handman teaches recommendation (i.e. provides a list of songs that are similar to the repertoire of an artist or CD; it will allows us to generate recommendations for an end user) [0094].

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Gross with the teachings of Handman to include the claimed, recommendation with the motivation to compare attributes of items the consumer previously indicated he or she enjoys with attributes of other items to identify items that the consumer might enjoy. Thus, for example, if the consumer enjoys "Dubliners" by James Joyce, "Ulysses" by James Joyce might be identified as another item the consumer may enjoy because both "Dubliners" and "Ulysses" have a common attribute (the author, James Joyce), (Handman, [0004]).

Regarding Claim 18, Gross teaches transmitting the content list user (i.e. such as subject, author, etc) [0073][0074] to the user terminal device corresponding to the user (i.e. terminals 104 and 502) [0173]-[0174].

Regarding Claim 19, Gross teaches transmitting means (Figure 1, item 113) for transmitting the content list to the user terminal device corresponding to the user [0713] to [0174].

Gross does not expressly teach recommendation.

Handman teaches recommendation (i.e. provides a list of songs that are similar to the repertoire of an artist or CD; it will allow us to generate recommendations for an end user) [0094].

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Gross with the teachings of Handman to include the claimed, recommendation with the motivation to compare attributes of items the consumer previously indicated he or she enjoys with attributes of other items to identify items that the consumer might enjoy. Thus, for example, if the consumer enjoys "Dubliners" by James Joyce, "Ulysses" by James Joyce might be identified as another item the consumer may enjoy because both "Dubliners" and "Ulysses" have a common attribute (the author, James Joyce), (Handman, [0004]).

Based on Applicant's comment that the newly added limitation, "assigning points to the content the favorite content list in inverse proportion to a number of contents listed in the corresponding favorite list", Examiner asserts that these limitations are taught by the prior art made of record, Gross (i.e. the quality of the links can be scored based on a variety of parameters, including the number of different domains the links link to, how many links are alive or broken (i.e. a broken link is a hyperlink that does not

work), and other parameters. Thus, for example, the higher the number of different domains the links link to and the greater the number or percentage of alive links) (Examiner's note: based on the percentage of the alive links, content lists of the favorites can be accessed) [0127]).

Examiner respectfully asserts that the applied portions and combination of Gross and Handman teaches and are obvious over Applicant's claimed invention of favorites in a networking environment in which favorites are ranked and recommendations are generated based on ranking.

Therefore, Claims 13-19 stand rejected at this time.

Dependent claim 18 is also asserted not to be allowable for substantially the same reasons as claim 14, and more specifically, for the respective limitations they recite.

Dependent claims 17 and 19 are also asserted not to be allowable for substantially the same reasons as claim 16, and more specifically, for the respective limitations they recite.

It is noted, *PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN* "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson,

397 F.2d 1006, 1009, 158 USPQ 275,277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including non preferred embodiments (see MPEP 2123).

Based on the newly submitted amendment and Applicant's arguments, Examiner has reconsidered Applicant's remarks. The rejection, supra, is maintained at this time.

Applicant is invited to further amendment the claims to overcome the prior art made of record. Examiner asserts that the prior art made of record teaches Applicant's claimed invention. At this time, the claims are not allowable over the prior art made of record.

Applicant's arguments with respect to the claims have been considered but are moot in view the rejection above and the rejection stated in this office action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday (9:30 - 4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

/Diane Mizrahi/

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Primary Patent Examiner

March 23, 2009